



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/491,899 | 01/27/2000 | William R. Wells | 3735-929 | 9213 |

27717 7590 03/01/2006

SEYFARTH SHAW LLP
55 E. MONROE STREET
SUITE 4200
CHICAGO, IL 60603-5803

EXAMINER

MAHMOUDI, HASSAN

ART UNIT PAPER NUMBER

2165

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|--------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/491,899 | WELLS ET AL. | |
| | Examiner | Art Unit | |
| | Tony Mahmoudi | 2165 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6, 8-10, 12, 13 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) is/are withdrawn from consideration.
- 5) ☐ Claim(s) is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-10, 12, 13 and 21-30 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claim(s) are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u> </u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u> </u> | 6) <input type="checkbox"/> Other: <u> </u> |

DETAILED ACTION

Remarks

1. In response to communications filed on 13-December-2005, claims 11, 15-17, and 19 are cancelled, claims 1, 8, and 24 are amended per applicant's request. Therefore, claims 1-3, 5-6, 8-10, 12-13, and 21-30 are presently pending in the application, of which, claims 1, 8, and 21-24 are presented in independent form.

Claim Objections

2. Claims 29 and 30 are objected to as depending from a canceled claim. In the Amendments filed by the applicant on 13-December-2005, claim 15, on which claims 29 and 30 depend, was canceled by the applicant. The applicant is required to either cancel claims 29 and 30, or re-route their dependencies to other claim(s).

Claim Rejections - 35 USC § 112 (1st Paragraph)

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 2165

4. Claims 21-23 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 21 and 22 recite the limitation “creating a first authenticator.” The specification does not describe the “creation of authenticator(s)” in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 23 recites the limitation “electronic transfer” is steps (d) through (f). The specification does not describe the “electronic transfer” in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear from either claim 23 or the disclosed specification whether the “electronic transfer” specifies “electronic transfer” of goods (game) from the gaming device to the user, or “electronic transfer” of user information (e.g. authenticators) from the user to the gaming device, or both. The specification does not describe “electronic transfer”, the entity being transferred, and the parties between which the transfer is being completed.

5. Claims 21-23 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the

Art Unit: 2165

relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 21 and 22 recite the limitation “creating a first authenticator.” The specification does not describe the “creation of authenticator(s)” in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 23 recites the limitation “electronic transfer” is steps (d) through (f). The specification does not describe the “electronic transfer” in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear from either claim 23 or the disclosed specification whether the “electronic transfer” specifies “electronic transfer” of goods (game) from the gaming device to the user, or “electronic transfer” of user information (e.g. authenticators) from the user to the gaming device, or both. The specification does not describe “electronic transfer”, the entity being transferred, and the parties between which the transfer is being completed.

Claim Rejections - 35 USC § 112 (2nd Paragraph)

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2165

7. Claims 1-3, 5-6, 8-10, 12-13, and 21-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Newly Amended Independent Claim 1:

Newly amended independent claim 1 recites, "*the player*" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Amended claim 1 further recites, "a reader, coupled to the gaming terminal which receives *said biometric data stored on said debit card*" in lines 7-8, which renders the claim indefinite. According to lines 2-3 of claim 1, "biometric data for the player" is stored on "a portable biometric data storage device". The "debit card" is identified to be "separate from the gaming apparatus". There is no mention of the debit card storing the player's biometric data in claim 1. Therefore, there is no sufficient antecedent basis for the limitation of "*said biometric data stored on said debit card*" recited in claim 1.

Furthermore, amended claim 1, in lines 11-12 recite, "a comparator for comparing said measured biometric data to *said stored biometric data*", which renders the claim indefinite in view of the limitation of lines 7-8 as explained above. "said stored biometric data" does not specify whether *said biometric data* is the *biometric data* stored on the portable biometric data storage device (recited in line 2) or the *biometric data* stored on the debit card, as recited in lines 7-8.

Claim 1 also recites, "*the debit card balance*" in line 14. There is insufficient antecedent basis for this limitation in the claim.

Claims 2-3, 5-6, and 27 are rejected as dependents of rejected independent claim 1.

Newly Amended Independent Claim 8:

Newly amended independent claim 8 recites, “*the gaming apparatus*” in line 4. There is insufficient antecedent basis for this limitation in the claim.

Amended claim 8 recites, “wherein said reader receives *said first biometric data stored on said debit card*” in line 8, which renders the claim indefinite. According to lines 2-3 of claim 8, “first biometric data for a player” is stored in “a portable biometric data storage device”. The “debit card” is identified to be “separate from the gaming apparatus”. There is no mention of the debit card storing the player’s biometric data in claim 8. Therefore, there is no sufficient antecedent basis for the limitation of “*said first biometric data stored on said debit card*” recited in claim 8.

Amended claim 8, in line 11 also recites, “comparing said measured biometric data to *said biometric data*”, which renders the claim indefinite in view of the limitation of lines 7-8 as explained above. The claim does not specify whether “*said biometric data*” is the *biometric data* stored on the portable biometric data storage device (recited in lines 2-3) or the *biometric data* stored on the debit card, as recited in line 8.

Claim 8 also recites, “*the debit card balance*” and “*the gaming device*” in line 14. There is insufficient antecedent basis for these limitations in the claim.

Claims 9-10, 12-13, and 28 are rejected as dependents of rejected independent claim 8.

Newly Amended Independent Claim 24:

Newly amended independent claim 24 recites, “*the gaming apparatus*” in lines 4 and 13. There is insufficient antecedent basis for these limitations in the claim.

Amended claim 24 recites, “reading *said biometric data stored on said card*” in line 8, which renders the claim indefinite. According to lines 2-3 of claim 8, “first biometric data for a player” is stored in “a portable biometric data storage device”. The “debit card” is identified to be “separate from the gaming apparatus”. The debit card stores player’s “*personal preference data*”, which is different from “*biometric data*”. There is no mention of the debit card storing the player’s biometric data in claim 24. Therefore, there is no sufficient antecedent basis for the limitation of “*said biometric data stored on said card*” recited in claim 24.

Amended claim 24, in line 10 also recites, “comparing said measured biometric data to *said stored biometric data*”, which renders the claim indefinite in view of the limitation of lines 7-8 as explained above. The claim does not specify whether “*said stored biometric data*” is the *biometric data* stored on the portable biometric data storage device (recited in lines 2-3) or the *biometric data* stored on “said card”, as recited in line 8.

Claim 24 also recites, “*the debit card balance*” in line 13. There is insufficient antecedent basis for these limitations in the claim.

Claim 24 also recites, “*said first user*” in line 15. There is insufficient antecedent basis for this limitation in the claim as the amended claim 24 replaced “user” with “player” throughout the claim.

Claims 25-26 are rejected as dependents of rejected independent claim 24.

8. In view of the above rejections made under 35 U.S.C. 112, second paragraph, necessitated by the applicant's amendments, it is not clear from the amended independent claims as to where the biometric data needs to be stored in and/or retrieved from. Hence, the newly amended independent claims 1, 8, and 24 are no longer searchable with respect to prior art.

Response to Arguments

9. Applicant's arguments filed on 13-December-2005 with respect to the rejected claims under 35 U.S.C 103(a) in view of the cited references have been fully considered but they are moot in view of the new grounds for rejection (paragraphs 6-7 of this Office Action.)
10. Applicant's arguments filed on 13-December-2005 with respect to claims 21-23, rejected under U.S. C. 112 first paragraph, have been fully considered but they are not deemed persuasive:

In response to the applicant's "chart outlining the specification support for claims 21-23", the chart has been carefully reviewed but the examiner is not satisfied with the cited portions of the specification of the instant application satisfying all the limitations of the claimed invention as represented by claims 21-23.

With respect to the recitation of “creating a first authenticator”, recited in claims 21 and 22, and the recitation of having a first and/or a second “authenticator” recited in claim 23, neither the “creation of authenticators” nor the term “authenticator” is taught in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not mention anything about “creation” or “creating” or “authenticator(s)” anywhere throughout the document.

The term “authenticator”, recited in independent claims 21-23, generally defines a person, routine, system, or mechanism used for determining authenticity. An “authenticator”, as defined by dictionaries (e.g. Dictionary.com) has the following meaning:

au·then'ti-ca'tor

***n.* : one who determines authenticity (as of works of art) or who guarantees validity [syn: appraiser].**

The disclosure of the instant application does not support this definition and does not provide any other definition for the term “authenticator” as recited in the rejected claims. The applicant refers to page 4, line 29 through page 5, line 6 of the specification. The cited portion teaches acquiring biometric references and obtaining personal and/or financial information. The specification does not teach as to how an “authenticator” is “created” from the acquired data. Lines 1-4 of page 6 of the specification, as cited by the applicant to support the teaching of the “creation of an authenticator” also only talks about storing biometric reference information and gathering information about the player/user. Again, the examiner does not see how this information is related “creation” of an “authenticator”.

Further, with respect to claim 23, the examiner still does not relate “a desired electronic transfer” to, as argued by the applicant, “electronic funds transfer”. The terms “electronic transfer” or “funds transfer” do not appear anywhere throughout the originally filed specification document.

In view of the above arguments, the examiner maintains the rejections of claims 21-23 under 35 U.S.C. 112, first paragraph.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2165

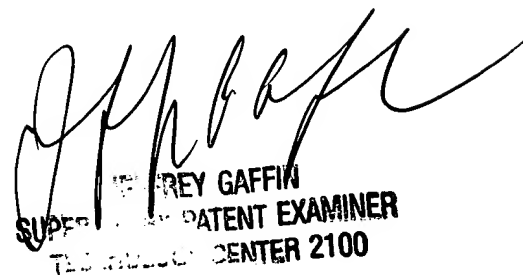
12. The claims for which interference is being sought (claims 21-23) remain rejected in this Office Action, under 35 U.S.C. § 112 (paragraphs 3-5 of this Office Action.) Accordingly, interference proceedings will not be established at this time. Any future consideration for the interference proceedings would require overcoming the above mentioned rejections.

13. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Tony Mahmoudi whose telephone number is (571) 272-4078. The examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached at (571) 272-4146.

tm

February 14, 2006



JEFFREY GAFFIN
SUPERVISOR
PATENT EXAMINER
TECHNICAL CENTER 2100